REMARKS

35 U.S.C. § 112, 1st Paragraph (Enablement)

Claims 1, 2, and 32 have been rejected under 35 U.S.C. § 112, 1st Paragraph, enablement. Applicants traverse this rejection.

MPEP § 2164.01(a) states the following: "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation." This section further states that: "The determination that 'undue experimentation' would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations." Factors such as predictability of the art, state of the prior art, nature of the invention, breadth of claims and working examples are few factors that need to be considered in the context of making an enablement determination. MPEP § 2164.01(a) further states that: "It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole." (Emphasis added).

Applicants submit that above-mentioned factors weigh in favor of Applicants claims meeting the enablement requirement and specifically support a finding that the claimed formulation could be made and used without undue experimentation. Several reasons support this conclusion.

First, making a monomer, generally, with various types of substituents, is well known in the prior art, as well as the general nature of what monomers are and the use of monomers as building blocks for making polymers through polymerization techniques, e.g. free radical polymerization, is known and understood in the prior art.

Secondly, the predictability of the art weighs favorably for the claimed invention, because polymerization techniques are generally known in art, specifically, Applicants have conveyed this through a previously submitted declaration which outlines what free radical polymerization encompasses and how one of ordinary skill in the art can identify whether a compound is capable of free radical polymerization.

Thirdly, Applicants provide working examples of how to make and the use some of the claimed compounds, starting at page 31 of specification. There is no requirement that the synthesis of every monomer is shown; all that is required is that there is a guide map as to how to make and use the claimed invention.

Fourthly, the quantity of substituents is not that cumbersome, the Markush groups are very limited in scope and thus the breadth of claims weighs favorably into a finding of enablement.

In view of the foregoing, Applicants submit that specification would enable one of ordinary skill in the art to make and use the claimed invention because the evidence as a whole supports this conclusion.

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CONCLUSION

Applicants respectfully request that a Notice of Allowance be sent for all pending claims.

Respectfully Submitted,

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